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10/090,685

03/05/2002

Alfred Thomas

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02/25/2008

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EXAMINER

MENDIRATTA, VISHU K

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALFRED THOMAS, DUNCAN F. BROWN,
LAWRENCE E. DEMAR, and
SCOTT D. SLOMIANY

Appeal 2007-2444
Application 10/090,685
Technology Center 3700

Decided: February 25, 2008¹

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

STATEMENT OF THE CASE

Thomas, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 25-48 and 50-52. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

¹ An oral hearing was conducted on Feb. 20, 2007.

We find that the appeal is not in condition for a decision. This application is remanded to the Examiner to address the matters specified below and to take action deemed appropriate.

The following rejections were presented in the Final Rejection (mailed Aug. 1, 2005; pp. 4-5):

1. Claims 25-48 and 50-52 are rejected under 35 U.S.C. § 102(e) as being anticipated by Tarantino.
2. Claims 25-48 and 50-52 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Simunek.
3. Claims 37-38 and 44-46 are rejected under 35 U.S.C. § 103(a) as unpatentable over Tarantino and Simunek.

The Appeal Brief (filed Jun. 8, 2006) listed the grounds of rejection to be reviewed on appeal as follows:

1. Claims 25-48 and 50-52 are rejected under 35 U.S.C. § 102(e) as being anticipated by Tarantino.
2. Claims 25-48 and 50-52 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Simunek.
3. Claims 25-48 and 50-52 are rejected under 35 U.S.C. § 103(a) as unpatentable over Tarantino and Simunek.

The last ground of rejection does not match a rejection set forth in the Final Rejection. Also, with respect to this last ground of rejection, the Appeal Brief (pp. 9-10; paragraph C) addresses only claims 25, 29, 39, 47, and 50. Accordingly, the Appeal Brief does not address the rejection of claims 37-38 and 44-46 under 35 U.S.C. § 103(a) over Tarantino and Simunek as raised by the Examiner in the Final Rejection.

The subsequent Examiner's Answer (mailed Sep. 5, 2006) states, incorrectly, that the "Appellant's statement of the grounds of rejection to be reviewed on appeal is correct." Answer 2. Also, the Examiner responded to the Appellants' arguments as to the Appellants' last ground of rejection by stating that "[o]n page 9, paragraph C, applicant's arguments are moot. There is [sic, no] record of independent claims 25, 29, 39, 47 and 50 rejected over Simunek in view of Tarantino." Answer 6. Accordingly, notwithstanding that the Examiner incorrectly indicated that the Appellants' statement of the grounds of rejection in the Appeal Brief was correct, the Examiner correctly observed that the Appellants addressed claims which were not rejected under 35 U.S.C. § 103(a) over Tarantino and Simunek. The Appellants corrected this in the Reply Brief.

In the Reply Brief (filed Nov. 3, 2007), the Appellants addressed the rejection of claims 37-38 and 44-46 under 35 U.S.C. § 103(a) as unpatentable over Tarantino and Simunek for the first time. The arguments are new. See Reply Br. 5-7.

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The Examiner responded to the Reply Brief by indicating that “the reply brief filed 11/3/06 has been entered and considered.” Paper, mailed Jan. 1, 2007.

The record shows that the Appellants first addressed the rejection of claims 37-38 and 44-46 under 35 U.S.C. § 103(a) over Tarantino and Simunek in the Reply Brief. The arguments in the Reply Brief with respect to this rejection are new and were not previously raised. There is no indication that the Examiner considered the new arguments. We remand the application to the Examiner for consideration of the new arguments set forth in the Reply Brief and to respond in a manner that makes the Examiner’s position as to the persuasiveness of these arguments clear on the record.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

REMAND

vsh

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